

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Dunn et al.**

Serial No.: **10/757,109**

Group Art Unit: **3644**

Confirmation No.: **2938**

Filed: **January 14, 2004**

Examiner: **Abott, Yvonne R.**

For: **STYPTIC APPLICATOR WITH FILE**

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This is a response to the Examiner's Answer dated November 9, 2009, in relation to the above-identified application:

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

This Reply Brief is submitted in response to the Examiner's Answer dated November 9, 2009. The new Examiner's Answer is the result of an order from the Board of Patent Appeals and Interferences requiring the Examiner to address claims 32 and 66, which the Examiner had failed to address in previous Office Actions. The Examiner now rejects claims 32 and 66 under 35 U.S.C. § 102(b) as anticipated in view of U.S. Patent No. 2,273,559 to Burnett (hereinafter "Burnett"). This new rejection is addressed below as well as the previous submitted rejection of claims 11, 30 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Burnett.

The Examiner's Answer additionally states that the Appellant must exercise the options of reopening prosecution or maintaining the appeal. The Appellant is maintaining the appeal and addresses the new grounds of rejection below. In addressing the new grounds of rejection no new amendments have been made.

1. New Grounds of Rejection

Claims 11, 30 and 57 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Burnett.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." See *MPEP 2143.03*.

The Examiner's newly provided rejection still does not address the deficiencies that have previously been noted regarding the disclosure of Burnett. Claims 11, 30 and 57 depend either directly or indirectly from claims 1, 23 and 47. Claims 1, 23 and 47 each require a styptic. Burnett has no disclosure of styptic. The Examiner's answer glosses over this omission in Burnett by suggesting that any powder may be a styptic.

See *the Examiner's Answer*, pp. 4 and 9. This is faulty logic. Not all powders are styptic, much like not all animals are dogs.

Therefore, each and every limitation of the claims is not met by the prior art and thus a *prima facie* case for obvious has not been properly established with respect to claims 11, 30 and 57.

It is additionally noted that one of ordinary skill in the art would not have modified Burnett in the manner required by claims 11, 30 and 57 for the reasons suggested by the Examiner.

"If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See *MPEP 2143.01*.

The Examiner in the newly provided rejection states that although it is not disclosed in Burnett that the filing device has a herringbone pattern, such a pattern would have been obvious. The Examiner's rationale for modifying Burnett's invention in such a manner is provided below:

"it would have obvious to one of ordinary skill in the art at the time the invention was made to provide that the filing device have a herringbone cross-hatch pattern as one of many various cutting/trimming patterns in order to maximize the release of the filed substance to thereby increase the filing effect. Additionally, a herringbone pattern would facilitate ease in gripping the file device. Further, to make the pattern of the Burnett file herringbone is considered to be an obvious design modification lacking disclosed criticality since with respect to a herringbone pattern, Appellant states only that their "filing device 14 can be made of any number of materials including emery board material, metal, sandpaper, etc. In a preferred embodiment the filing device will have a herringbone crosshatch." See *the Examiner's Answer*, p. 5.

It is first noted that this newly provided rejection is conjecture by the Examiner. No evidence has been provided that teaches using a herringbone pattern for filing nails of animals. The Examiner has not provided any suggestion from the prior art for doing so. Besides this lack of evidence on the part of the Examiner, the Examiner has also failed to provide proper motivation for modifying the file disclosed by Burnett in order to achieve the device as claimed.

As discussed in the Brief, Burnett teaches a compact vanity case that a human may use. The Examiner's rationale that one would modify Burnett in order "to maximize the release of the filed substance to thereby increase the filing effect" is not a logical one in the context of the disclosure of Burnett, which indicates that the disclosed device is intended for use with human fingernails as well to avoid damaging the interior of a purse. See *Burnett*, col. 1, lines 1-20. The Examiner's suggestion that one would modify Burnett in order to increase the filing effect does not take into account that the file in Burnett would be used for human nails, while the file of the Appellant's invention is to be used with animal nails, which are thicker and more coarse than human nails. The factors that one takes into account in order to obtain a manicured effect in humans are different than those taken in order to obtain well groomed pet nails.

The Appellant respectfully submits that one of ordinary skill in the art would not modify the file in Burnett in order to increase the amount of nail material removed, as suggested by the Examiner, since such enhanced nail removing ability would render the file unsatisfactory for the purpose of manicuring human nails.

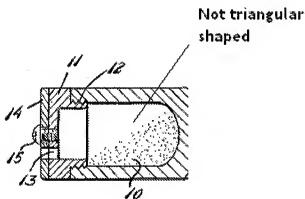
Furthermore, as suggested by the Examiner, facilitating the ease with which one grips the file device is immaterial in the context of the Burnett disclosure since, Burnett explicitly teaches using the receptacle 6 as the handle for the file 21. See *Burnett*, col. 2, lines 20-23.

As discussed above, the proposed modification of Burnett, as suggested by the Examiner, would render Burnett unsatisfactory for its intended purpose. For at least these additional reasons claims 11, 30 and 57 are in condition for allowance.

The Examiner newly rejects claims 32 and 66 as being anticipated by Burnett under 35 U.S.C. § 102(b). This is accomplished not by directly addressing the limitation of the claims, but by simply including the numbers 33 and 66 in the preamble's listing of claims rejected.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP 2131.

Claims 33 requires having a concave shape that is triangular. This claim is referring to the area intended to hold powder 10 and is shown below:



From the figure one can see that the concave shape is not triangular. For at least this additional reason claim 33 is in condition for allowance since Burnett does not anticipate it.

Claim 66 requires having a styptic and a spout. Burnett discloses having a powder. This powder is not a styptic. Therefore Burnett does not meet this limitation since there is no disclosure of styptic in Burnett.

Burnett also does not disclose having a spout. The Examiner points to discharge port 13 as being the spout. Merriam-Webster's online dictionary defines a spout as a "projecting tube or lip from which a liquid (as water) issues." See www.m-w.com. The discharge port 13 in Burnett is a tunnel through closure plug 11 and not a projecting tube.

Discharge port 13 is not a spout and for at least this additional reason the limitations of claim 66 are not met.

2. Reply to the Examiner's Response

a. The rejections under 35 U.S.C. §102(b)

The Examiner responds to the brief by stating that “Burnett clearly shows a chamber for holding a powder (10), which is well known to be used as a clotting or styptic material.” See *Examiner's Answer*, p. 9. The Appellant respectfully submits that the statement that a powder “is well known to be used as a clotting or styptic material,” is unsupported by any evidence and is logically flawed.

There is no mention of a styptic material in Burnett. Merriam-Webster's online dictionary defines styptic as “tending to contract or bind: ASTRINGENT; *especially*: tending to check bleeding.” See www.m-w.com. A “styptic material” is a chemical or substance that is used in order to stop bleeding. This is used in the Appellant's invention because during the grooming of some animals, such as dogs, when a nail is clipped, the veins that are embedded within the nail may be damaged thereby causing bleeding. The Examiner points to the disclosure of “powder” in Burnett and suggests that this is enough to provide teaching of a styptic material. Merriam-Webster's defines powder as “matter in a finely divided state: particulate matter.” See www.m-w.com. The powder used in Burnett is for cosmetic purposes not for the usage of stopping bleeding. Simply because a type of material may take the physical form of a powder is not sufficient to provide teaching of the material itself. By the same logic, the Examiner could suggest that a disclosure of a container capable of holding liquid (such as a juice bottle), would be sufficient to provide teaching of gasoline. This is flawed.

Furthermore, the Examiner points to element 13 of Burnett and refers to it as a “spout or port.” See the *Examiner's Answer*, pp. 9 and 10. The Appellant respectfully submits that this is in error. Discharge port 13 is not a spout. Merriam-Webster's online dictionary defines a spout as a “projecting tube or lip from which a liquid (as water) issues.” See www.m-w.com. The

discharge port 13 in Burnett is a tunnel through closure plug 11 and not a projecting tube, as suggested by the Examiner.

Additionally, with respect to claims 5, 27 and 51, the Examiner additionally states that the “shank end of the file is considered to meet this limitation.” The Appellant respectfully notes that the attachment member, as claimed, is an additional element that is part of the file and not the file itself. Therefore, the limitations of claims 5, 27 and 51 are not met by indicating that the file may be removed.

The Examiner additionally argues that “Appellants state that the cap is not flush with a side of the container as state in claims 18 and 36, however, Figure 4, does not show that covering means or cap (20) is indeed flush with a side; also the cap is shown (Figure 5) to be removable as required by claim 60.” With respect to cap being flush, the Appellant submits that Figures 1, 2, 4 and 5 of the Application show the cap being flush. Furthermore, this argument appears to be misplaced since it does not address the structure of Burnett at all and appears to making formalistic argument regarding the Appellant’s claims.

For at least reasons listed above the rejection under 35 U.S.C. §102(b) is in error and this error is not remedied by the Examiner’s Answer.

b. The rejections under 35 U.S.C. §103(a)

On page 10 of the Examiner’s Answer it is suggested that U.S. Patent No. 2,290,886 to Lenz (hereinafter “Lenz”) discloses a handle on a removable cap. The Examiner points to the cap 25 and the elastic cord 27 which keeps the cap 25 attached to the outer tube 21 in Lenz. See *Lenz*, col. 2, lines 49-54. Despite what the Examiner states, the elastic cord 27 is not a handle.

On page 10 of the Examiner’s Answer, the Examiner again suggests that Burnett discloses an apparatus for dispensing styptic. As discussed above and in the Brief, Burnett does not disclose a styptic material.

On page 10 of the Examiner’s Answer, the Examiner suggests that it would have been obvious to modify Burnett with the handle taught by Lenz in order to facilitate easy carriage and handling of the article. However, the Appellant notes that there is no motivation for modifying the vanity cases taught by Burnett with a cord on a styptic pencil. Since Burnett teaches placing

the vanity case in a purse, there would be little reason to place a strap on the vanity case. Furthermore, there would be no reason for combining art from two disparate fields such as women's cosmetic cases and a styptic pencil.

On page 11 of the Examiner's Answer, the Examiner argues that "Burnett was applied to Griffiths, Jr. [U.S. Patent No. 5,762,077 to Griffiths, Jr. (hereinafter "Griffiths")] *solely to teach that the fluid is powder styptic.*" [emphasis added]. The Appellant again notes that styptic is not taught in Burnett. Assuming *arguendo* one were motivated to replace the nail polish with the powder disclosed in Burnett, you still would not arrive at the Appellant's invention. The Appellant again maintains that the 35 U.S.C. § 103(a) rejection based on Griffiths in view of Burnett is in error.

On page 12 of the Examiner's Answer, the Examiner argues that "Burnett was added [to U.S. Patent No. 5,897,262 to Bratby-Carey (hereinafter "Bratby-Carey")] to teach the obviousness of powder as the fluid in the Bratby-Carey applicator, especially since it is well known to apply powder (such as acrylic) to nails." The Appellant again notes that styptic is not taught in Burnett. Assuming *arguendo* one were motivated to replace the fluid with the powder disclosed in Burnett, you still would not arrive at the Appellants invention. The Appellant again maintains that the 35 U.S.C. § 103(a) rejection based on Bratby-Carey in view of Burnett is in error.

It is finally noted that adding styptic powder to a cosmetic device for humans is not obvious since humans do not have veins in their nails that would require the stoppage of bleeding and the usage of styptic. Burnett, Griffiths and Bratby-Carey are all related to cosmetic devices and are not used for the grooming of pets. It is not suggested in any of the references that their disclosed devices be used with pets. The Examiner still has not properly addressed this issue.

3. Conclusion

The Appellant has made an earnest effort to respond to the Examiner's Answer and remove any doubt regarding the inapplicability of the cited prior art in the Office Actions presented by the Examiner.

Respectfully submitted,

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